

REMARKS

Claims 1-19 had been pending in this application with all claims rejected. In connection with the co-filed RCE, claims 1-13 have now been cancelled. Claim 14 has been amended. Claims 20-27 have been added. At least in light of the above amendments and the foregoing remarks, reconsideration and allowance of the claims is respectfully requested.

Claims Rejections – 35 U.S.C. § 102

Claims 1 and 11-18 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,864,868 (Contois).

Contois does not allow selection of two or more, but less than all, of topic criteria from a list. Instead, Contois only allows either (a) a single selection before a compile is done to reduce the lists in the other categories (e.g. Contois FIG. 6), or (b) a selection of all categories by use of the “All Categories” button. Selecting the “All Categories” button is not helpful for winnowing down a list as with the present invention.

Contois allows only a single selection within each of the listed mutually exclusive data fields: genre, composer, artist, song. Furthermore, all multiple selections (e.g. selecting both a composer and artist) would result in a compile for each of these selections.

Terminology chosen within some of the newly added claims further distinguish against Contois (which has a similar preamble). For example, “topic criteria” is terminology listed within the specification while “list” and “simultaneous display” of topic criteria are shown in Applicants’ FIG. 1.

Remarks made in a prior paper that highlight the distinguishing characteristics of the invention over Contois is included below for convenience, but are additionally relevant with the amendments now made to the pending claims.

Claims 14, 20, and 25 are the sole independent claims in the application. Each claim includes the following limitation:

- CLAIM 14: “selecting at least two, but less than all, of the top-level categories from the list” and “performing a single compile on the selected top-level categories . . .”
- CLAIM 20: “allowing a multiple selection by the user of two or more, but less than all, of the topic criteria from the list” and “selecting in a single compile a sub-list . . .”

- CLAIM 25: “user interface means, displayed on the display means, for displaying the list of topic criteria so that the user may simultaneously select two or more and less than all topic criteria from the list;”

Concerning the single compile limitation, the result of such a single compile is to present to the user a sub-list of media content items fulfilling all of the two or more/at least two categories selected (a matter discussed at length in previous responses and not repeated here). The absence of these claim elements from the prior art of record (Contois and May) is incompatible with a rejection of the claims §102 and §103. These rejections must therefore be removed.

Responsive to Applicant’s Appeal Brief, the Examiner has withdrawn rejection of the claims under the May reference (U.S. Patent No. 5,544,354). Because of May’s use of “one-at-a-time” selection, May cannot be altered or combined with another reference (e.g., Contois) to enable the claim 14/20 limitation of performing/selecting for presentation in a single compile a sub-list from multiply-selected top-level categories. Also, because of May’s use of “one-at-a-time” selection, May would never be able to select for presentation *only* those media content items associated with *all* of the two or more top-level categories selected as stated in claim 1. Instead, May (in combination with Li) would present *all* media content items associated with *any one of* the two or more top-level categories in multiple sub-lists, each associated with a different top-level category.

Contois has been cited in the Office Action as curing these deficiencies. However, and as explained below, Contois performs a compile with each selection made and therefore cannot satisfy the current claim language of performing a single compile responsive to multiple selections.

Contois teaches a music library access system whereby a user can select from displayed lists of ‘Category’, ‘Composer’, ‘Artist’, and ‘Selected Song’ to narrow a selection down to the specific song to be played. Though the user is allowed to select from multiple categories, each selection causes a compile to

“Contois performs a compile with each selection made and therefore cannot satisfy the current claim language of performing a single compile responsive to multiple selections.”

occur and a redisplay of the other categories to suit the item selected. For instance, selecting ‘Beethoven’ from the ‘Artist’ list causes all of the other data fields to only display data found in the data base that pertains to the composer Beethoven. (col. 10, lines 28-30) In this way, Contois

acts as a hierarchical database such as described in the May reference. Contois, in other words, cannot fulfill the claim 14 and 20 limitation of allowing selection of two or more top-level categories where the sub-list presented to the user is the result of a single compile. Instead, Contois performs a first compile when a first element is chosen (to narrow down the list in the other data fields), and a second compile when the second element is chosen (to further narrow down the list – e.g. FIG. 6). In other words, election of two or more top-level categories does not result in a single compile, but rather a compile occurs following each selection (see '868 FIG. 7 and explanatory text at Col. 12, line 30 et seq).

There is a further distinction between the present inventive as claimed and the Contois reference, namely that Contois explicitly states that selection of two or more top-level categories within the same group results in a list containing entries which satisfy any of the selections (the logical OR operation; see col. 13 lines 34-39). Selecting 'classical' and 'jazz' categories will list all selections that satisfy either of the selections. By their nature none of the examples cited by Contois make sense in the context of the present invention. That is, typically a data entry for a song is considered to belong only to one category; a song has only one composer; a song has only one performer. Therefore, the notion that a user would wish to view all songs that were both 'classical' and 'jazz' is non-sensical, as is an attempt to view all songs that were composed by both Liszt and Duke Ellington. Contois does not describe a database containing songs with such characteristics, nor would one assume such a characteristic of a typical music database. In contrast, the application as described and claimed clearly describes a situation where at least one element in the database (and typically many such elements) belongs simultaneously to two or more top-level categories (for example, a film being both Comedy and Science Fiction) so that the selection of multiple top-level categories is a plausible action in our scenario (but not in the invention of Contois).

The operation of the Contois media selection system is shown in the Figures in the following page:

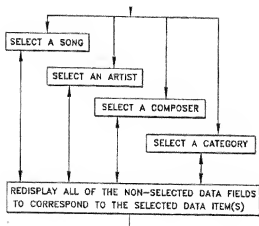
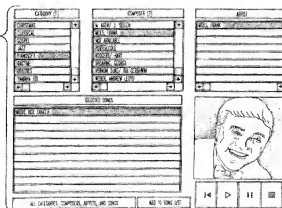


FIG. 6



The Contois figures above (FIG. 7 and FIG. 6, respectively) illustrate the method for finding a media file. The flow chart shows that each selection causes a redisplay of all the non-selected data fields to correspond to the selected data item(s) – as evident from the double-sided arrows and disclosure within the Contois specification. In other words, each selection causes a single compile. Therefore, there is no way to enact a single compile on a multiple selection.

In the Example shown in FIG. 6, the “pianosoft” category is first selected. The other categories reconfigure themselves to only display composers, artists, and songs corresponding to the pianosoft category selected. The “Mills, Frank” composer selection is then made. Again, the other categories reconfigure themselves to only display artists and songs with both pianosoft and Mills, Frank. Thus far there have been at least two compiles. Only the “Mills, Frank” artist entry and “Music Box Daneer” song fulfill these selections. The selected entry is thus ready for play, but only after at least two compiles.

One should consider that what is shown by Contois as the output of a search process is a list of specific songs. Each of these specific songs is a recording of a single performance. One performance of a given composition might be done in a jazz style, and might thus be categorized under ‘jazz’. A different performance of the same composition might be done in a classical style, and have the corresponding categorization. However, these are two different entries in the database; neither individual performance (‘song’) would appear under the two categories.

Consider FIG. 3, which shows multiple entries all labeled ‘MOONLIGHT SONATA, OP. 27, NO. 2, MVT. 1’ – each was composed by Beethoven, but the three entries have different performers and thus are different ‘songs’. They might be performed in different styles, but

whether this assigns them to different categories is never addressed by Contois, and is not implied by his application, nor necessarily 'obvious to one skilled to one in the art'.

In any case, Contois never considers the case where a single song (that is, recorded performance) could belong to multiple categories, and it is not obvious how that would arise from his invention or description.

This in contrast with the present invention where multiple top-level selections occur and then a single compile takes place:

MOVIE	CATEGORIES						
	ACTION	ADVENTURE	ADULT	COMEDY	DRAMA	FOREIGN	MUSICAL
1	X	X					
2			X				
3			X		X		
4	X			X			X
5				X			
6					X		X
7				X		X	
8					X		
9		X			X	X	
10			X	X			X
11							X
12		X			X		
13	X						
14	X	X				X	

FIG. 5

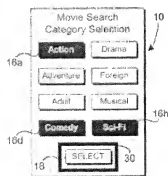


FIG. 3

As neither Contois nor May, or a suggested combination of the two references, teach performing a single compile on multiple but not all selections, rejection of the claims under §102 or §103 would be inappropriate.

Claim Rejections – 35 U.S.C. § 103

Claims 2, 3, 5-10 and 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Contois, in view of U.S. Patent No. 5,544,354 (May, et al.). May fails to teach the missing elements from the Contois reference, making rejection of the claims under §103(a) legally deficient.

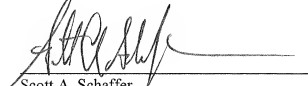
CONCLUSION

For the foregoing reasons, reconsideration and allowance of claims 14-27 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Customer No. 20575

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Scott A. Schaffer
Reg. No. 38,610

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
503-222-3613